



UNITED STATES PATENT AND TRADEMARK OFFICE

T

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,686	09/04/2003	Thomas J. Friedman	SP03-107 (WJT003-0045)	8554
22928	7590	09/05/2007		
CORNING INCORPORATED			EXAMINER	
SP-TI-3-1			BALDWIN, GORDON	
CORNING, NY 14831				
			ART UNIT	PAPER NUMBER
			1775	
			MAIL DATE	DELIVERY MODE
			09/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,686	Applicant(s) FRIEDMAN ET AL.	
	Examiner Gordon R. Baldwin	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 20, 21 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 20, 21, 26, 27, 28, 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17, 20-21, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,461,709 B1 to Janssen et al. in view of U.S. Patent Okada (6,098,809).

Regarding claims 17, 20, 26 and 27, Janssen discloses a glass sheet for windows displays and signage covered with removable protective sheets on both sides of the glass sheet either of which may or may not contain embossed images or graphics (regular patterns) (column 3 lines 29-32, column 6 lines 48-50, column 16 lines 5-7,

column 19 lines 59-62 and figure 13). This provides for either both sides have embossed features or one does and one does not. An image embossed on the sheets and deposited on both sides of the glass would have an inverse and therefore different position from the opposite side thereby creating a presence of air pockets. Janssen discloses the film may be made from materials such as polyolefins and polyethylenes and blends thereof (column 5 lines 5-11). Janssen does not disclose multiple sheets stacked next to one another in a container. However, Okada discloses a container with a top and a bottom and four sides with one having a door that opens to allow the placement of such items as silica glasses and other delicate substrates to be placed next to each other. (Col. 3 lines 1-45 and figures 6, 11, 13)

Because Okada's containers are used to protect a plurality of flat substrates such as silica glass stacked next to one another, it would have been obvious to a person having ordinary skill in the art at the time of the invention to use the container of Okada to package and protect a stack of glass sheets such as those disclosed by Janssen in order to protect the sheets during any storage, handling or shipping operations.

Regarding claim 21, A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Regarding claims 28 and 29, Janssen discloses a glass sheet for windows displays and signage covered with removable protective sheets on both sides of the glass sheet either of which may or may not contain embossed images or graphics (regular patterns) (column 3 lines 29-32, column 6 lines 48-50, column 16 lines 5-7, column 19 lines 59-62 and figure 13). This provides for either both sides to have embossed features or one does and one does not. An image embossed on the sheets and deposited on both sides of the glass would have an inverse and therefore different position from the opposite side thereby creating a presence of air pockets.

However, Janssen does not specifically state that the embossed or printed film is going to differ from the top protective film to the bottom reflective film in shape and position. But, the change in position of the reflective sheet is considered to be an obvious rearrangement of the invention since it would have been obvious to a person of ordinary skill in the art at the time of the invention to change the position of the sheet since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

As for the changes in the shape of the embossed pattern of the top and bottom layer, this is considered to be a the only difference between this recitation and the prior art is a change in relative dimensions that is not considered to perform differently that the Janssen reference, which are both used to protect panel surfaces. Therefore no patentable distinction is discernable. In re Gardner v. TEC Systems Inc. 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984, cert denied, 469 U.S. 830, 225 USPQ 232 (1984).

Claims 17, 20-21, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,461,709 B1 to Janssen et al. in view of Tapp U.S. Pat. No. 5,678,593.

Regarding claims 17, 20, 26 and 27, Janssen discloses a glass sheet for windows displays and signage covered with removable protective sheets on both sides of the glass sheet either of which may or may not contain embossed images or graphics (regular patterns) (column 3 lines 29-32, column 6 lines 48-50, column 16 lines 5-7, column 19 lines 59-62 and figure 13). This provides for either both sides have embossed features or one does and one does not. An image embossed on the sheets and deposited on both sides of the glass would have an inverse and therefore different position from the opposite side thereby creating a presence of air pockets. Janssen discloses the film may be made from materials such as polyolefins and polyethylenes and blends thereof (column 5 lines 5-11). Janssen does not disclose multiple sheets stacked next to one another in a container. However, Tapp discloses a container that is used to store glass sheets with a top and a bottom and four sides with a door or lid (22) that opens to allow the placement of such items as glass sheets and other delicate substrates next to each other and stored safely. (Figure 2 and 3 and (Col. 2 lines 34-52)) The door is considered to be on the first side since that is the location of the locking or latching mechanism in figures 2 and 3.

Because Tapp's containers are used to protect a plurality of flat glass substrates stacked next to one another, it would have been obvious to a person having ordinary

Art Unit: 1775

skill in the art at the time of the invention to use the container of Tapp to package and protect a stack of glass sheets such as those disclosed by Janssen in order to protect the sheets during any storage, handling or shipping operations.

Regarding claim 21, A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Regarding claims 28 and 29, Janssen discloses a glass sheet for windows displays and signage covered with removable protective sheets on both sides of the glass sheet either of which may or may not contain embossed images or graphics (regular patterns) (column 3 lines 29-32, column 6 lines 48-50, column 16 lines 5-7, column 19 lines 59-62 and figure 13). This provides for either both sides to have embossed features or one does and one does not. An image embossed on the sheets and deposited on both sides of the glass would have an inverse and therefore different position from the opposite side thereby creating a presence of air pockets.

However, Janssen does not specifically state that the embossed or printed film is going to differ from the top protective film to the bottom reflective film in shape and position. But, the change in position of the reflective sheet is considered to be an obvious rearrangement of the invention since it would have been obvious to a person of ordinary skill in the art at the time of the invention to change the position of the sheet

Art Unit: 1775

since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

As for the changes in the shape of the embossed pattern of the top and bottom layer, this is considered to be a the only difference between this recitation and the prior art is a change in relative dimensions that is not considered to perform differently that the Janssen reference, which are both used to protect panel surfaces. Therefore no patentable distinction is discernable. In re Gardner v. TEC Systems Inc. 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984, cert denied, 469 U.S. 830, 225 USPQ 232 (1984).

Response to Arguments

Applicant's arguments with respect to claims 17, 20, 21, 26 and 27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

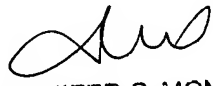
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon R. Baldwin whose telephone number is (571)272-5166. The examiner can normally be reached on M-F 7:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1775

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GRB


JENNIFER C. MCNEIL
SUPERVISORY PATENT EXAMINER
9/3/17